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10/564,934	01/13/2006	Jean-Marie Poulet	CRE-17902	5171
40854 7590 04/07/2010 RANKIN, HILL, & CLARK LLP 38210 Glenn Avenue WILLOUGHBY, OH 44094-7808				
EXAMINER AHVAZI, BILAN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/564,934

## Applicant(s)

POULET ET AL.

## Examiner

BIJAN AHVAZI

## Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-13, 15, 16, 18-21, 23, 24, 26-32, 39-41, 43-45, 47-49 and 51-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15, 16, 18-21, 23, 24, 26-32, 39-41, 43-45, 47-49 and 51-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/19/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the amendment filed on January 19, 2010.
2. Claims 11-13, 15, 16, 18-21, 23, 24, 26-32, 39-41, 43-45, 47-49, and 51-62 are pending. Claims 11, 18-19, 30, and 62 are amended. Claim 42 is cancelled. Claims 14, 17, 22, 25, 33-38, 46, and 50 are previously cancelled.
3. The rejection of claims 11-13, 15, 16, 18-21, 23, 24, 26-32, 39-45, 47-49, 52-62 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the applicants' amendment.
4. The declaration under 37 CFR 1.132 filed on 01/19/2010 is insufficient to overcome the rejection of claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51-62 based upon 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) in view of Jung *et al.* (Pub. No. US 2004/0062873 A1) as set forth in the last Office action (See *Response to Arguments*).
5. Claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51, 53-62 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) in view of Jung *et al.* (Pub. No. US 2004/0062873 A1).
6. Claim 52 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) and Jung *et al.* (Pub. No. US 2004/0062873 A1) as applied to claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51, 53-62 as above and further in view of Phillips *et al.* (Pat. No. US 5,250,325).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51, 53-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) in view of Jung *et al.* (Pub. No. US 2004/0062873 A1).

Regarding claims 11, 18-20, 28, 30, 39 and 40-41, 43, 59 and 62, Maze *et al.* teach an anti-corrosion coating composition for metal parts, characterized in that it comprises: at least one particulate metal; an organic solvent; a thickener; a silane-based binder, preferably carrying epoxy functional groups; molybdenum oxide (MoO<sub>3</sub>); possibly a silicate of sodium, potassium or lithium, and; water (Page 3, lines 10-20) wherein the content of molybdenum oxide MoO<sub>3</sub> is preferably between 0.5 and 7% and even more preferably in the region of 2% by weight of the total composition (Page 3, line 23). Advantageously, the particulate metal content is between 10% and 40% by weight of metal with respect to the weight of the composition (Page 3, line 36). Such a composition also makes use of a binder, preferably an organofunctional silane, used in an amount of 3% to 20% by weight (Page 4, line 34). Preferably, the useful silane is an epoxy functional silane such as  $\beta$ -(3, 4-epoxycyclohexyl) ethyltrimethoxysilane, 4-(trimethoxysilyl) butane-1, 2 epoxide or  $\gamma$ -glycidoxypentyl- trimethoxysilane (Page 5, line 3). Maze *et al.* teach an anti-corrosion coating composition for metal parts wherein the anti-corrosion coating compositions can also contain, in addition to the organic solvent such as a glycol ether, in

particular diethylene glycol, triethylene glycol and dipropylene glycol (Page 4, line 18), up to a maximum amount of approximately 10% by weight of white spirit so as to improve the ability of the anti-corrosion compositions to be applied to the metal parts by spraying, dipping or dip-spinning (Page 5, line 7). Advantageously, the composition may also contain a silicate of sodium, potassium or lithium, preferably in an amount from 0.05 % to 0.5 % by weight (Page 5, line 14). The anti-corrosion composition also contains from 0.005% to 2% by weight of a thickening agent (Page 4, lines 21-27) and possibly a silicate of sodium, potassium or lithium, and; water (Page 3, lines 10-20). Maze *et al.* do not expressly teach a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium and neodymium, in the form of oxides and a lubricating agent to obtain a self-lubricated system selected from the group consisting of polyethylene, MoS<sub>2</sub>, graphite, polysulfones, polytetrafluoroethylene, synthetic or natural waxes and nitrides, and their mixtures.

However, Jung *et al.* teach method of coating metallic surfaces and also to the use of the coated substrates produced in particular in vehicle construction, especially in the line manufacture of automobiles, and for the production of components or bodywork parts or premounted elements in the vehicle, air travel or space travel industry (Page 1, ¶0001). The anticorrosion layer(s) ought to be readily formable together with the paint or a paintlike layer and ought also to exhibit, after forming, effective corrosion protection and effective paint adhesion. Additionally, depending on the joining technique, it may be necessary for said layer(s) to be readily clinchable as well without showing a greater tendency toward corrosion as a result (Page 1, ¶0003). Jung *et al.* teach a method of coating a metallic strip, the strip, or where appropriate strip sections produced from it, in the subsequent operation being first coated with at least one anticorrosion layer and then with at least one layer of a paintlike, polymer-containing layer, the

strip, after coating with at least one anticorrosion layer or after coating with at least one layer of a paintlike coating, being divided into strip sections, the coated strip sections then being formed, joined and/or coated with at least one (further) paintlike layer and/or paint layer, the paintlike coating being formed by coating the surface with an aqueous dispersion which comprises besides water a) at least one organic film former comprising at least one water-soluble or water-dispersed polymer having an acid number in the range from 5 to 200, b) at least one inorganic compound in particle form, having an average particle diameter, and c) at least one lubricant and/or at least one corrosion inhibitor, the metallic surface coated with at least one anticorrosion layer being contacted with the aqueous composition and a particle-containing film being formed on the metallic surface, and subsequently dried and, as the case may be, additionally cured, the dried and, as the case may be, additionally cured film having a thickness in the range from 0.01 to 10  $\mu\text{m}$  (Page 32, Claim 1). Jung *et al.* teach the inorganic compound in particle form that is added is a finely divided powder, a dispersion or a suspension, such as, for example, a carbonate, an oxide, a silicate or a sulfate, especially colloidal and/or amorphous particles. With particular preference the inorganic compound in particle form comprises particles based on at least one compound of lanthanum, of silicon, of titanium, of yttrium, of zinc and/or of zirconium, especially particles based on alumina, barium sulfate, lanthanide oxide(s) based (read on praseodymium or neodymium) (Page 6, ¶0051), cerium dioxide (read on cerium oxide or  $\text{CeO}_2$ ), silica, silicate, titanium oxide, yttrium oxide (read on  $\text{Y}_2\text{O}_3$ ), zinc oxide and/or zirconium oxide (read on  $\text{ZrO}_2$ ) (Page 5, ¶0043) in an amount of in the range from 0.1 to 80 g/L, more preferably in an amount in the range from 1 to 50 g/L, very preferably in an amount in the range from 2 to 30 g/L (Page 34, Claim 59) wherein inorganic compound is characterized in that the aqueous composition comprises from 0.1 to 500 g/L (reads on the same % by weight of the instant applicants) of the at least one inorganic compound in particle form (Page 33, Claim 24).

Jung *et al.* teach the inorganic compound in particle form that is added is a finely divided powder, a dispersion or a suspension, such as, for example, a carbonate, an oxide, a silicate or a sulfate, especially colloidal and/or amorphous particles such as yttrium oxide (Page 5, ¶0043), since "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure such as yttrium oxide, the properties applicant discloses and/or claims such as a size and  $D_{50}$  are necessarily present. See MPEP 2112.01(I) or the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it held that a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as taught by Jung *et al.* as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Jung *et al.* further teach to add as a lubricant, which may also serve as a forming agent, at least one wax selected from the group consisting of paraffins, polyethylenes, and polypropylenes, especially an oxidized wax (Page 5, ¶0045), preferably from 0.1 to 100 g/L, more preferably from 20 to 40 g/L or from 0.1 to 10 g/L, very preferably 0.4 to 6 g/L, for example, a crystalline polyethylene wax (Page 12, ¶0134). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify an anti-corrosion coating composition for metal parts by Maze *et al.* so as to include a reinforcing agent for the anticorrosion properties of the composition as taught by Jung *et al.* with reasonable expectation that this would result in improving the anti-corrosion properties of parts treated without using a composition based on reinforcing agent in the formulation of the coatings with

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less toxic risk and less adverse consequences for the environment as taught by Jung *et al.* (Page 2, ¶[0016]).

Regarding claims 12, 13, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the content of molybdenum oxide  $\text{MoO}_3$  is preferably between 0.5 and 7% and even more preferably in the region of 2% by weight of the total composition (Page 3, line 23).

Regarding claims 15, 16, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the particulate metal present in the composition can be chosen from zinc, aluminium, chromium, manganese, nickel, titanium, their alloys and intermetallic compounds, and mixtures thereof (Page 3, lines 26-30).

Regarding claims 21, 44 and 45, Maze *et al.* teach the anti-corrosion coating composition for metal parts, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it held that a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as taught by Maze *et al.* as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Regarding claims 23 and 51, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the organofunctionality can be represented by vinyl, methacryloxy and amino, but is preferably epoxy functional for enhanced coating performance as well as



composition stability. The silane is advantageously easily dispersible in aqueous medium, and is preferably soluble in such medium (Page 4, line 35). The other component of the binder is also selected from a silicate of sodium, potassium or lithium (Page 3, line 17).

Regarding claim 24, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein preferably, the useful silane is an epoxy functional silane such as  $\beta$ -(3, 4-epoxycyclohexyl) ethyltrimethoxysilane, 4-(trimethoxysilyl) butane-1, 2 epoxide or  $\gamma$ -glycidoxypyl- trimethoxysilane (Page 5, line 3).

Regarding claims 26, 27, 53, 54, 55 and 56, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the anti-corrosion composition also contains from 0.005% to 2% by weight of a thickening agent (read on up to 7% by weight of the instant applicants), in particular of a cellulose derivative, more particularly hydroxymethylcellulose, hydroxyethylcellulose, hydroxypropylcellulose, hydroxypropylmethylcellulose, xanthan gum or an associative thickener of the polyurethane or acrylic type (Page 4, lines 21-27) and possibly a silicate of sodium, potassium or lithium, and; water (Page 3, lines 10-20).

Regarding claims 29, 31, 32 and 57, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the standard reference GEOMET® composition in Example 1 corresponds to 0.65% of a weak mineral such as boric acid, 0.4% of Schwego Foam® (emulsified antifoam), and 0.53% of Aerosol® TR70 (an anionic surfactant) (Page 8, line 20).

Regarding claims 47, 48, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the anti-corrosion coating compositions can also contain, in addition to the organic solvent such as a glycol ether, in particular diethylene glycol, triethylene glycol and dipropylene glycol (Page 4, line 18), up to a maximum amount of approximately 10% by weight of white spirit so as to improve the ability of the anti-corrosion compositions to be applied to the metal parts by spraying, dipping or dip-spinning (Page 5, line 7).

Regarding claim 49, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein advantageously, the composition may also contain a silicate of sodium, potassium or lithium, preferably in an amount from 0.05 % to 0.5 % by weight (Page 5, line 14).

Regarding claim 58, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the particulate metals have a lamellar form, the thickness of the flakes being comprised between 0.05  $\mu\text{m}$  and 1  $\mu\text{m}$  and having a diameter equivalent ( $D_{50}$ ) (Page 2, lines 30-33).

Regarding claim 60, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the molybdenum oxide  $\text{MoO}_3$  is used in an essentially pure orthorhombic crystalline form, having a molybdenum content greater than approximately 60% by mass (Page 3, lines 1-3).

Regarding claim 61, Maze *et al.* teach the anti-corrosion coating composition for metal parts wherein the molybdenum oxide  $\text{MoO}_3$ , will be used in the anti-corrosion compositions in the form of particles having dimensions of between 1 and 200  $\mu\text{m}$  (Page 3, lines 5-7).

9. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) and Jung *et al.* (Pub. No. US 2004/0062873 A1) as applied to claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51, 53-62 as above and further in view of Phillips *et al.* (Pat. No. US 5,250,325).

Regarding claim 52, Maze *et al.* and Jung *et al.* teach the features as discussed above. Maze *et al.* and Jung *et al.* do not expressly teach an anticorrosion coating composition for metal parts wherein the binder is associated with a phenolic cross- linking agent or an aminoplastic cross-linking agent.

However, Phillips *et al.* teach an anticorrosion coating composition containing certain alkanolic acid salts, as corrosion inhibitors; as well as those alkanolic acid salts which are novel (Col. 1, lines 4-7). Preferred adducts of an epoxide resin with an amine are adducts of a polyglycidyl ether, which can be of a polyhydric phenol or a polyhydric alcohol, with a monoamine. Suitable polyglycidyl ethers include those of dihydric alcohols such as butane-1, 4-diol, neopentyl glycol, hexamethylene glycol, oxyalkylene glycols and polyoxyalkylene glycols, and tri-hydric alcohols such as glycerol, 1,1,1-trimethylolpropane and adducts of these alcohols with ethylene oxide or propylene oxide (Col. 6, lines 60-68). It will be understood by those skilled in the art that these polyglycidyl ethers of polyhydric alcohols are usually advanced, i.e. converted into longer chain higher molecular weight polyglycidyl ethers, for example by reaction with a dihydric alcohol or phenol, so that the resulting polyglycidyl ethers give adducts with suitable electrodepositable film-forming properties on reaction with the secondary monoamine (Col. 7, lines 1-8). Preferred polyglycidyl ethers are those of polyhydric phenols, including bisphenols such as bisphenol F, bisphenol A and tetrabromobisphenol A and phenolic novolak resins such as phenol-formaldehyde or cresol-formaldehyde novolak

resins. These polyglycidyl ethers of phenols may have been advanced, for example by reaction with dihydric alcohols or phenols such as those described. Particularly preferred polyglycidyl ethers are polyglycidyl ethers of bisphenol A advanced by reaction with bisphenol A (Col. 7, lines 8-18). Monoamines suitable for adduct formation with the polyglycidyl ethers include primary, secondary or tertiary amines. Secondary amines are preferred e.g. dialkylamines such as diethylamine, di-n-propylamine, di-isopropylamine, di-n-butylamine, di-n-octylamine and di-n-dodecylamine or nitrogen heterocycles such as piperidine or morpholine (Col. 7, lines 19-24). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify an anti-corrosion coating composition for metal parts by Maze *et al.* in view of a reinforcing agent for the anticorrosion properties of the composition by Jung *et al.* so as to include a phenolic or aminoplastic cross-linking agents as taught by Phillips *et al.* with reasonable expectation that this would result in providing conversion into longer chain higher molecular weight polyglycidyl ethers, for example by reaction with a dihydric alcohol or phenol, so that the resulting polyglycidyl ethers give adducts with suitable electrodepositable film-forming properties on reaction with the secondary monoamine as taught by , Phillips *et al.* (Col. 7, lines 1-8) and thus improve the anti-corrosion properties of parts treated without using a composition based on reinforcing agent in the formulation of the coatings with less toxic risk and less adverse consequences for the environment.

***Response to Arguments***

10. Applicant's arguments filed on 01/19/2010 have been fully considered but they are not persuasive.

In response to applicant's argument that the claimed compositions, as recited by the amended claims, now call for a particular weight percentage concentration of a certain reinforcing agent in the form of an oxide.

The Examiner respectfully disagrees. Maze *et al.* teach an anti-corrosion coating composition for metal parts, characterized in that it comprises: at least one particulate metal; an organic solvent; a thickener; a silane-based binder, preferably carrying epoxy functional groups: molybdenum oxide ( $\text{MoO}_3$ ); possibly a silicate of sodium, potassium or lithium, and; water (Page 3, lines 10-20) wherein the content of molybdenum oxide  $\text{MoO}_3$  is preferably between 0.5 and 7% and even more preferably in the region of 2% by weight of the total composition (Page 3, line 23). Advantageously, the particulate metal content is between 10% and 40% by weight of metal with respect to the weight of the composition (Page 3, line 36). Maze *et al.* do not expressly teach a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium and neodymium, in the form of oxides

However, Jung *et al.* teach the inorganic compound in particle form that is added is a finely divided powder, a dispersion or a suspension, such as, for example, a carbonate, an oxide, a silicate or a sulfate, especially colloidal and/or amorphous particles. With particular preference the inorganic compound in particle form comprises particles based on at least one compound of lanthanum, of silicon, of titanium, of yttrium, of zinc and/or of zirconium, especially particles based on alumina, barium sulfate, lanthanide oxide(s) based (read on praseodymium or neodymium) (Page 6, ¶10051), cerium dioxide (read on cerium oxide or  $\text{CeO}_2$ ), silica, silicate,

titanium oxide, yttrium oxide, (read on  $Y_2O_3$ ), zinc oxide and/or zirconium oxide (read on  $ZrO_2$ ) (Page 5, ¶0043). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify an anti-corrosion coating composition for metal parts by Maze *et al.* so as to include a reinforcing agent for the anticorrosion properties of the composition such as cerium dioxide or titanium oxide, yttrium oxide (read on  $Y_2O_3$ ) (interchangeable for molybdenum oxide  $MoO_3$  of Maze *et al.*) as taught by Jung *et al.* with reasonable expectation that this would result in improving the anti-corrosion properties of parts treated without using a composition based on reinforcing agent in the formulation of the coatings with less toxic risk and less adverse consequences for the environment as taught by Jung *et al.* Since it is *prima facie* obvious that the  $MoO_3$  and  $Y_2O_3$  are considered to be equivalent (exchangeable), it is held that substitution of art recognized equivalents is within the level of ordinary skill in the art. (MPEP § 2144.06). Furthermore the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With regard to the declaration under 37 CFR 1.132 filed on 01/19/2010 is insufficient to overcome the rejection of claims 11-13, 15,16, 18-21, 23, 24, 26-32, 39-41, 43-45,47-49, 51-62 based upon 35 U.S.C. 103(a) as being unpatentable over Maze *et al.* (WO 02/38686 A2) in view of Jung *et al.* (Pub. No. US 2004/0062873 A1) as set forth in the last Office action, since the applicants argue that Jung *et al.* is nonanalogous art

The Examiner respectfully disagrees. In response to applicant's argument that Jung *et al.* is nonanalogous art, it has been held that a prior art reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Jung *et al.* teach method of coating metallic surfaces and also to the use of the coated substrates produced in particular in vehicle construction, especially in the line manufacture of automobiles, and for the production of components or bodywork parts or premounted elements in the vehicle, air travel or space travel industry (Page 1, ¶0001). The anticorrosion layer(s) ought to be readily formable together with the paint or a paintlike layer and ought also to exhibit, after forming, effective corrosion protection and effective paint adhesion.

In response to applicant's arguments against the references individually as recited in the the declaration under 37 CFR 1.132 filed on 01/19/2010, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the combinations of references such as Maze *et al.* in view of Jung *et al.* teach the recited limitations. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify an anti-corrosion coating

composition for metal parts by Maze *et al.* so as to include a reinforcing agent for the anticorrosion properties of the composition as taught by Jung *et al.* with reasonable expectation that this would result in improving the anti-corrosion properties of parts treated without using a composition based on reinforcing agent in the formulation of the coatings with less toxic risk and less adverse consequences for the environment as taught by Jung *et al.* (Page 2, ¶0016).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Examiner Information***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijan Ahvazi, Ph.D. whose telephone number is (571)270-3449. The examiner can normally be reached on M-F 8:0-5:0. (Off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the



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organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BA/  
Bijan Ahvazi,  
Examiner  
Art Unit 1796

/Harold Y Pyon/  
Supervisory Patent Examiner, Art Unit 1796

04/02/2010